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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,955	02/27/2004	Bradford G. Corbett SR.	20470.076	6676

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EXAMINER
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FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/788,955

Applicant(s)

CORBETT ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment and response filed July 17, 2006 is are noted. Claims 1-25 remain pending, of which claims 1-13 and 25 are withdrawn.
2. The compliant abstract filed August 7, 2006 is also noted and appreciated.

### ***Response to Arguments***

3. Applicant's arguments, see the remarks, filed July 17, 2006, with respect to the objections set-forth in the prior Office action have been fully considered and are persuasive. These objections are withdrawn.
4. The rejection under 35 USC 112, 2<sup>nd</sup> Para., set-forth in the prior Office action, is moot in view of the cancellation of claim 26.
5. Applicant's arguments filed July 17, 2006 have been fully considered but they are not persuasive.

A. Applicant has amended independent claim 14 to recite "an asphalt-free method." While this amendment narrows the scope of the claim and better defines applicant's invention, it does not distinguish over Kucera. This reference is silent with respect to whether or not the coating composition contains asphalt, which is a fair teaching that the composition does not contain asphalt.

B. Applicant has amended the claims to recite "a ductile iron pipe." While this amendment narrows the scope of the claim and better defines applicant's invention, it does not render the claims non-obvious. Phelps et al. (US 4,254,165 A) is introduced

below as teaching that it is also known to coat the internal surfaces of ductile iron pipes to protect against corrosion.

C. Applicant has amended the claims to recite that the pipe component "forms a part of a water or sewer line." While this amendment narrows the scope of the claim and better defines applicant's invention, it does not render the claims non-obvious. While Phelps is directed to a ductile iron pipe broadly, such pipes are known and used as water or sewer lines, in the conventional sense. Further, Phelps discloses an embodiment in which the pipe is used to carry steam [5:1-30] which, of course, is water. Consequently, Phelps teaches a water line.

D. Applicant's arguments having been fully considered in light of the amendment, the examiner rejects claims 14-24 as set-forth below.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**8. Claims 14-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kucera et al. (US 6,383,307 B1) in view of Phelps et al. (US 4,254,165 A).**

A. Kucera teaches the anti-corrosion composition claimed by applicants. As noted above, because this reference does not explicitly state that the composition necessarily contains asphalt, it fairly teaches that the composition is free of asphalt. The composition is autodepositable and may be applied to ferrous substrates including iron by dipping and drying (i.e., solidifying).

While Kucera teaches that the composition may be applied to a ferrous substrate such as iron, the reference does not explicitly state that the substrate is “a ductile pipe component which forms part of a water or sewer system.”

As noted above, Phelps teaches that it is known to coat the internal surfaces of a ductile iron pipe, including one that conveys water, to protect the pipe from corrosion [5:1-30].

Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Kucera so as to utilize, as the ferrous substrate, a ductile iron water pipe. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of providing the water pipe with an anti-corrosion coating as is known in the art; said coating further possessing superior corrosion resistance and fracture toughness as disclosed by Kucera [1:60-62].

B. With specific respect to claim 17, it is clear from Kucera that the composition may be advantageously applied to any metal object in a waterworks that comes into contact with water. Since waterworks components commonly and

conventionally include, in addition to pipes, fittings, it would have been obvious to one of ordinary skill in the art to apply Kucera's coating to a fitting, as recited in this claim.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those

portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Phillip Fletcher III  
Patent Examiner (FSA), USPTO  
Art Unit 1762

Fredericksburg, VA  
October 10, 2006